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| In re Application of | : | |
| FUNG, et al. | : | |
| PCT No.: PCT/US04/43501 | : | DECISION ON PETITION |
| Application No.: 10/583,927 | : | |
| Int. Filing Date: 23 December 2004 | : | UNDER 37 CFR 1.47(a) |
| Priority Date: 23 December 2003 | : | |
| Atty. Docket No.: 12279-187-999 | : | |
| For: NOVEL ANTI-IL-13 ANTIBODIES AND USES | : | |
| THEREOF | : | |

This decision is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a)" filed 29 September 2008 in the United States Patent and Trademark Office (USPTO). In addition, this decision incorporates applicant's "Supplemental Response to Notification of Defective Response" filed on 17 October 2008.

BACKGROUND

On 23 December 2004, applicant filed international application PCT/US04/43501 which claimed priority to an earlier application filed 23 December 2003 Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 23 June 2006.

On 22 June 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 09 April 2007, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was also directed to file a statement as to the content of the sequence listing and a copy of the sequence listing in computer readable form (CRF). Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 08 June 2007, applicant filed an executed combined declaration and power of attorney and a statement regarding the sequence listing. In addition, applicant provided a statement that a

CRF of the sequence listing was filed in the international phase of the application.

On 21 August 2007, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) advising applicant that the filed declaration did not comply with 37 CFR 1.497(a)-(b) and that there was a discrepancy as to the names of the first and third inventors as they appeared on the published international application and the filed declaration. Applicant was again advised to provide a CRF of the sequence listing. Applicant was afforded one month to respond or any extendable time which remained from the mail date of the Form PCT/DO/EO/905.

On 25 September 2007, applicant filed a response accompanied by a petition for a four-month extension of time. As to the discrepancy in the names of the inventors, applicant provided a statement from counsel that the individuals listed as the first and third inventors on the published international application and the filed declaration were the same people and that the "problem occurred due to their legal names vs. names the scientists go by in the United States."

On 20 December 2007, applicant filed a transmittal for revocation and power of attorney.

On 29 August 2008, applicant was mailed an additional "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) advising applicant that the filed declaration did not comply with 37 CFR 1.497(a)-(b) and that there was a discrepancy as to the names of the first and third inventors as they appeared on the published international application and the filed declaration. Applicant was again advised to provide a CRF of the sequence listing. Applicant was afforded one month to respond or any extendable time which remained from the mail date of the Form PCT/DO/EO/905.

On 29 September 2008, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventor Changning Yan accompanied by a CRF of the sequence listing and sequence listing statement.

On 17 October 2008, applicant filed a supplemental petition which included a declaration executed by inventor Yan.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted above, applicant filed a declaration signed by inventor Yan on 17 October 2008 and therefore the petition is dismissed as moot. However, the declaration filed 29 September

2008 does not comply with 37 CFR 1.497(a)-(b).

Specifically, MPEP Section 201.03 states that:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The filed declaration contains five separate signature pages individually executed by the inventors. This suggests that either the filed declaration was compiled from numerous declarations or that the inventors only returned their signature pages. Either scenario renders the document non-compliant.

It is noted that the original declaration filed 08 June 2007 was similarly non-compliant and that applicant's response of 25 September 2007 did not adequately address the defects detailed in the Form PCT/DO/EO/916 mailed 21 August 2007. As the filed declaration has been found to be non-compliant, applicant has not provided a proper and timely response to the Form PCT/DO/EO/916 mailed 29 August 2008 and the application is abandoned as to the United States.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED as moot**.

This application is **ABANDONED** as to the United States National Stage and is being forwarded to the United States Designated /Elected Office for the preparation and mailing of a "Notification of Abandonment" (Form PCT/DO/EO/909).



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